

### **REMARKS**

Claims 1-14 are currently pending. In the Office Action mailed December 4, 2008, the Examiner rejected claims 1-14 under 35 U.S.C. §112, first and second paragraphs, as failing to comply with the written description requirement and for being indefinite. The Examiner next reiterated the previous rejections of claims 1-4, 9, 10, and 12-14 under 35 U.S.C. §102(b) as being anticipated by Harada et al. (U.S. Patent 5,522,466); claims 1, 2, 4, 9, 10, 12, and 13 under 35 U.S.C. §102(b) as being anticipated by UK Patent Application '045 (UK Patent Application GB 2 171 045); and the rejection of claims 5-8 and 11 under 35 U.S.C. §103(a) has been unpatentable over Harada et al. or UK Patent Application '045 in view of Dunn (U.S. Patent 5,833,014).

#### **Finality of Office Action**

In the Office Action mailed July 28, 2008, the Examiner rejected several of the pending claims as being unpatentable over a combination of references that included U.S. Patent 5,833,014 to Dunn. Page 8 of the Response filed October 22, 2008, included several arguments directed to the non-analogous nature of this reference to the present invention. In the Office Action mailed December 4, 2008, the Examiner reiterated the previous rejections and in the "Response to Arguments" section on page 5 of the Office Action, the Examiner failed to address Applicant's arguments directed to the non-analogous nature of the Dunn reference. Accordingly, Applicant requests the Examiners consideration of the arguments presented in page 8 of the response filed on October 22, 2008 so that, as is provided by MPEP §706.07, this issue can be clearly developed prior to further prosecution of this matter.

#### **Outstanding Rejections**

The Examiner rejected claims 1-14 as failing to comply with both the first and the second paragraphs of 35 U.S.C. §112. With respect to the second paragraph rejection, the Examiner identified the recitations of "the handle housing" in line 9 and "the guide device" in line 10 as being improper. The Examiner further suggested corrections to these limitations based on the appropriate interpretation of the usage of the respective language. Applicant has amended claim

1 in accordance with the Examiner's suggestions to overcome the 35 U.S.C. §112, second paragraph rejections. Accordingly, as the amendments were suggested by the Examiner, Applicant anticipates that the amendments presented herein will be entered after a final office as simplifying issues for appeal.

The Examiner rejected claims 1-14 under 35 U.S.C. §112, second paragraph first paragraph asserting that, "claim 1 has been amended to recite that the guide device is disposed between the handle and housing that allows relatively uninhibited movement of the handle device relative to the handle housing in the working direction" and that "... this mode of operation is not originally set forth in the specification." The Examiner further concludes "Such conditions can be inferred but such disclosure is not explicitly set forth." The Examiner, citing page 7, lines 15-17 of the specification, further asserts that the "specification teaches the contrary." The Examiner states that "the guide device is disclosed as enabling guiding of the handle relative to the housing transverse to the working direction, as well as in a rotational direction." As the Examiner's §112, first paragraph rejection is articulated in the terms suggested by the Examiner to overcome the second paragraph rejection, Applicant offers the following remarks regarding the compliance of claim 1 with the requirements of 35 U.S.C. §112, first paragraph. Applicant respectfully disagrees that that which is called for in claim 1 is inconsistent and/or otherwise inadequately disclosed in the specification.

Title 35 U.S.C. §112, first paragraph, states that "[t]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention." 35 U.S.C. §112, ¶1.

As articulated in MPEP §2163.II, "[t]he examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention

provides support for the claims.” MPEP §2163.II. Contrary to the Examiners conclusion, the Specification fully supports that which is called for in the pending claims even though the detailed description discloses more than what is necessary to define the present invention over the art of record. As cautioned in MPEP §2163.I.B, “there is no *in haec verba* requirement” with respect to claim limitations. The section further counsels that claim amendments can be supported through express, implicit, or inherent disclosure in the Specification. Although the Examiner maintains that the complained of subject matter in claim 1 can be inferred from the Specification, Applicant believes that which is called for in claim 1 is expressly and/or inherently disclosed in the specification, albeit not *in haec verba*, or in the exact same language as is used in the specification.

Claim 1 calls for, in part, a guide device for the linear guiding of the handle device relative to the hammer housing. Claim 1 further defines that the guide device 1) allows relatively uninhibited movement of the hammer housing relative to the handle device in a working direction (A), and 2) inhibits lateral and rotational movement between the hammer housing and the handle in directions other than the working direction (A). The fourth paragraph on page 7 of the specification states that:

Between handle cover 1 and hammer housing 2, which is made of plastic or metal, there is provided a guide device 7 that enables at least a linear guiding of handle cover 1 relative to hammer housing 2 in working direction A (impact direction, longitudinal direction) of the hammer, but preferably also enables a guiding of handle cover 1 relative to hammer housing 2 transverse to the working direction, and in a rotational direction about the percussion axis oriented in the working direction.

The third paragraph on page 9 of the specification discussing Fig. 3 ends with:

In this way, already with the two roller elements 9 shown in Figure 3 it is possible to ensure that handle cover 1 is guided relative to hammer housing 2, and cannot deviate in a direction perpendicular to drive direction A.

Although the specification states that the guide arrangement prevents deviation in a direction perpendicular to the driving direction (A), an examination of Fig. 3 clearly indicates

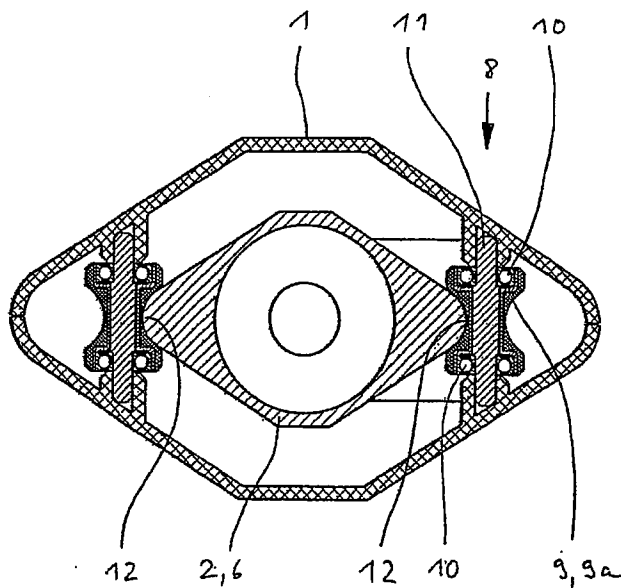


Fig. 3

that the arrangement inhibits lateral and radial translation of the hammer housing (2) relative to the handle cover (1).

As shown in Fig. 3 as reproduced at left, the specification clearly shows a guide system having rollers (9) that are generally hour-glass shaped and disposed on opposite sides of hammer housing (2). One skilled in the art would readily appreciate that the cooperation of hammer housing (2) with guide tracks (12) of the guide

assembly inhibits rotational and lateral translation between the hammer housing and the handle cover while allowing generally uninhibited translation in the working direction (A) which would be into and out of the page with respect to the cross-section view shown in Fig. 3.

Therefore, although not in the exact same language as used in the specification, Applicant believes that at least the above disclosure adequately supports that which is called for in the pending claims and satisfies the requirements of the 35 U.S.C. §112, first paragraph. Accordingly, Applicant respectfully requests that the 35 U.S.C. §112 rejection be withdrawn.

The Examiner next rejected claim 1 under 35 U.S.C. §102(b) as being anticipated by Harada et al. asserting that "... the guide device [of Harada et al.] allows relatively uninhibited movement of the handle relative to the housing in a working direction and inhibits lateral and

rotational movement between the handle and housing, as broadly claimed.” Applicant respectfully disagrees. Such an assertion disregards the express disclosure of Harada that the rollers of the guide system disclosed therein elastically deform during translation of the handle relative to the hammer housing.

The Examiner summarized Applicant’s previous arguments stating, “Applicant argues that Harada fails to disclose the invention since the movement of the handle relative to the housing is limited.” The Examiner continues, “Although this may be correct, Harada is deemed to disclose the invention as claimed, since Harada allows longitudinal movement with little resistance...” Such an assertion disregards the claim language that the guide element allows relatively uninhibited movement in the working direction between the hammer housing and the handle device and disregards the express disclosure of Harada et al. that the system dampens motion along this axis. In the simplest terms, the system of Harada et al. is a dampener as compared to the linear guide defined by the pending claims.

Harada et al. states that “when vibrations are generated from the tool body 1 during use in the direction Z, the elastic damper member 6 is elastically deformed in the direction Z ... [to] cause the inclined surfaces 13 and 15 of the elastic damper members 5 and 6 to move to each other so as to decrease the gaps between the inclined surfaces 13 and 15....” Col. 3, ll. 59-67. As a fundamental application of the theory of conservation of energy, the wedging of the respective roller elements of the vibration isolation system of Harada et al. clearly resists translation of the handle assembly relative to the hammer body in the working direction. Longitudinal displacement of the handle relative to the tool body, or displacement in the working direction of the tool, is limited, if not wholly eliminated, by the interaction of roller elements 4 with the generally curvilinear facing structures of damper portion 12 and damper member 6 of tool body.

Simply, the system of Harada et al. is directed to isolating the handle from the vibration of the tool in a shock mount manner. Wedging of the rollers in the respective channels clearly

evidences as much. Unlike Harada et al., the present invention, as defined by claim 1, is directed to a class of tool that requires generally unfettered translation of the tool housing in a working direction relative to a handle device. Those skilled in the art would appreciate that a guide system in the environment related to the present invention -- percussion tool assemblies, generally provide guided or steady or direct motion in some directions, i.e. a working directions, and inhibit, restrict, or hold in check motions in certain directions. The system of Harada et al. is configured to inhibit motion in all directions so as to provide a vibration isolation separation between the tool and the handle. Unlike Harada et al., the uninhibited relative movement in the working direction is commonly associated with a relative translation that yields operation of the tool. Even so, as Harada et al. expressly discloses that motion between the handle and the hammer body is restrained in the working direction, Harada et al. does not disclose a guide system that allows relatively uninhibited movement of the hammer housing relative to the handle device in the working direction as called for in claim 1. Accordingly, Applicant believes claim 1, and the claims that depend therefrom, are patentable over this reference.

The Examiner also rejected claim 1 under 35 U.S.C. §102(b) as being anticipated by UK Patent Application '045. Applicant respectfully disagrees.

Claim 1 calls for, in part, a guide device having a rolling element device that is disposed between the hammer housing and the handle device and that maintains an alignment between the hammer housing and handle device for allowing generally uninterrupted movement in the working direction (A) and limiting lateral and rotational movement between the guide device and hammer housing in directions other than the working direction (A). As previously argued, the system of UK Patent Application '045 is more nearly associated with the handle vibration dampening system of Harada et al. than the presently claimed invention. There is simply no structure in either of Harada et al. or UK Patent Application '045 that allows uninterrupted movement between working parts in a working direction and limits movement in non-working directions as called for in claim 1.

Both the systems of Harada et al. or UK Patent Application '045 are constructed to limit or dampen motion between the underlying tool and the handle in all directions. That is, the handles are generally offset or otherwise spaced from those portions of the tool that generate the working motion. The dampened connections provide for vibration isolation without detracting from operator manipulation of the tool in any given direction via the user's interaction with the handle.

Claim 1 further defines the guide device as having a roller element device that is disposed between the hammer housing and the handle device. Applicant does not disagree that UK Patent Application '045 discloses a system having rollers, but it is not the guide device that is constructed in such a manner. The rollers of the system of UK Patent Application '045 merely reduce friction associated with a spring that is disposed between the handle and tool assemblies. The "guide devices" of the embodiment shown in Fig. 1 of UK Patent Application '045 are the post and cavity arrangements (2a, 3, 3a) at the opposite top and bottom sides of the handle and the tool. A spring (4) biases the handle and tool housing in opposite directions along an axis aligned with the oppositely positioned posts. As such, that portion of UK Patent Application '045 that guides movement of the relative assemblies is devoid of a roller element device as called for in the present claims. Therefore, Applicant believes claim 1, and the claims that depend therefrom, are patentably distinct over the art of record.

Although Applicant believes claim 2-14 are patentable pursuant to the chain of dependency, Applicant believes the subject matter of claim 13 is independently patentable over the art of record. Claim 13 further defines that a portion of the tool housing has an outer prismatic shape whose edges are grasped by the rolling elements. There is no comparable structure disclosed in the art of record nor has the Examiner provided any support in this or the previous office action for wherein the art this feature is disclosed.

Therefore, at least for the reasons set forth above, Applicant believes claims 1-14 are patentably distinct over the art of record. Accordingly, Applicant respectfully requests a notice

Response to Office Action dated December 4, 2008  
U.S. Patent Application Ser. No. 10/596,298  
Inventor(s): Berger et al.  
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of allowance of claims 1-14. Although no fees are believed due for entry and consideration of this paper, the Office is hereby authorized to charge any fees that may be deemed necessary for this or any subsequent paper, or credit any overpayment, to Deposit Account No. 50-1170. The Examiner is cordially invited to contact the undersigned if any of the above merits further discussion or if any other informal matters remain which may hinder or otherwise delay passage of this matter to issuance.

Respectfully submitted,



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